

SN. 09/725,607

ATTORNEY DOCKET NO. CANO:015

REMARKS

Claims 1-27 and 29 remain pending in this application for which applicant seeks reconsideration.

Amendment

Claims 28 and 30 have been canceled, and independent claims 1, 7, 13, 17, 23, 27, and 29 have been amended to improve their form and to more clearly define the invention. The phrase "paper discharge" has been deleted as superfluous. These claims now define that the history information includes an operating mode that includes a plurality of settings of the image forming devices. No new matter has been introduced.

§ 112 Rejection

In the claims, the operating mode has been positively recited as part of the history information to more clearly define the invention. The examiner contends that broadly reciting a claim feature, and then narrowly reciting the same feature is somehow indefinite, relying on *Ex parte Wu*. *Ex parte Wu* relates to a situation where a claim recites a feature both positively and as an exemplary feature (using "such as"). This case is inapplicable here since the claims do not recite an exemplary feature, but rather explicitly recites a feature catered in an alternative ("one of"). If the examiner's standard were followed, then all dependent claims that further define an element broadly construed in the independent claim becomes indefinite. For example, if claim 1 recites an element A comprised of one of A1 and A2, and claim 2 recites that element A is composed of A1, then according to the examiner's standard, claim 2 would be indefinite. Applicant takes an Official Notice that the present § 112 rejection is improper. Should the examiner maintain this rejection, applicant requests an interview with the examiner in the presence of primary or supervisory primary examiner.

Art Rejection

Claims 1-3, 6-9, 12-19, and 22-26 were rejected under 35 U.S.C. § 103(a) as unpatentable over Wakasugi (JP 9-274547), and claims 4, 5, 10, 11, 20, 21, and 27-30 were

SN. 09/725,607

ATTORNEY DOCKET NO. CANO:015

rejected under § 103(a) as unpatentable over Wakasugi in view of Canon (JP 10-17202). The examiner asserts that Wakasugi discloses all of the features of independent claims 1, 7, 13, 17, and 23 except for clearing the history information relating the image processing when the history information is transferred. As to independent claims 27-30, the examiner asserts that Canon would have taught notifying the information processing apparatus upon the history information stored in the history information storage means reaching a predetermined amount. Applicant submits that the pending claims distinguish over Wakasugi at least because Wakasugi would not have taught storing an operating mode with the settings of the image forming device in its print log information.

The independent claims call for history information storage means or the step of storing history information, as part of the claimed apparatus or method. The history information includes an operating mode that includes a plurality of settings of the image forming device. The settings of the image forming device can include, for example, paper size, print mode, print color, paper material, etc., used for forming the image (e.g., printing). In this respect, the examiner asserts that Fig. 3 of Wakasugi discloses storing the operating mode in Wakasugi's print log information. Wakasugi discloses storing a print log information that includes the user name, protocol, data capacity, print status, print start and end time, and page description language (e.g., PostScript, RPD), as disclosed in paragraph 23 and Fig. 3 of Wakasugi. This print log information merely indicates the settings of all the users. In contrast to the examiner's understanding, Wakasugi does not include the settings of the printer itself. Indeed, Fig. 3 of Wakasugi illustrates no such operating mode, but rather only the print log information explained above. Moreover, as Wakasugi stores the history information relating to all users in a storage means 8 of its printer 5, Wakasugi faces the same problem of prior art discussed in the paragraph spanning pages 2-3 of the present specification.

Wakasugi neither discloses nor teaches including the operating mode of the image forming device as part of print log information or the number of sheets discharged. Because Wakasugi does not include the image forming information of the printer, the users have to search all the history of the print log information to find the number of discharged sheets.

SN. 09/725,607

ATTORNEY DOCKET NO. CANO:015

Applicant submits that Wakasugi would not have taught the invention set forth in the above-identified pending independent claims.


Further, independent claims 27 and 29 (and other dependent claims) call for notifying the amount of history information stored in the storage means upon reaching a predetermined amount. Wakasugi also would not have taught this feature as acknowledge by the examiner. The examiner, however, asserts that it would have been obvious, in view of Canon's error notification method, for Wakasugi to include the claimed notification system. Applicant disagrees because the error notification disclosed in Canon would not have motivated one of ordinary skill in the art to send a notification upon the amount of storage reaching a predetermined amount as there is no nexus therebetween.

Conclusion

Applicant submits that claims 1-27 and 29 patentably distinguish over the applied references and thus urges the examiner to issue an early Notice of Allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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